



Atty. Docket No. 1501-1111

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Jan ERIKSSON

Confirmation No. 4412

Serial No. 09/581,911

GROUP 3643

Filed June 19, 2000

Examiner A. Valenti

ANIMAL RELATED APPARATUS

RESPONSE

Commissioner for Patents

Washington, D.C. 20231

Sir:

This replies to the Official Action of August 28, 2002.

Reconsideration is respectfully requested, for the rejection of the claims as unpatentable over JAKOBSON et al. 4,508,058 in view of FINGER 4,712,195, or further in view of INNINGS et al. WO 96/36212.

The rejection falls down, because JAKOBSON et al. and FINGER are not properly combinable.

The JAKOBSON et al. system is correctly described by the Examiner. The shortcomings of JAKOBSON et al. for reference purposes are also described.

But FINGER does not supply the missing material of JAKOBSON et al.; and it would not have been obvious to a person of ordinary skill in the milking art, to have looked to FINGER for any useful teaching.

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The Official Action, at page 3, lines 5-7, seems to refer to FINGER in column 1 for a teaching of keeping the system clean to prevent the spread of bacteria and disease to the other members of the herd. Of course, FINGER does not teach this. Instead, FINGER is devoted to the field of aircraft and deals with problems that arise in aircraft. FINGER thus seeks to compensate undesirable changes in characteristics in response to changes in operating temperatures, and inherent physical limits of shock and vibration resistance. These are problems which arise in vehicles, more particularly aircraft, but have no counterpart in the milking field and hence would not attract the attention of a person of ordinary skill in the milking field.

Notice also that the assignee of FINGER, namely, Curtis Instruments, is prominent in the aircraft instrumentation field and has no connection with the milking field.

Just as the problems that arise in the aircraft instrumentation field are unique in the sense that they have no counterpart in the milking field, so also the problems that arise in the milking field are specific to that field and have no counterpart in the aircraft field.

Thus, in milking parlors or stalls, the humidity level is very high and gases such as ammonia and sulfur-containing gases are present in high concentration. This environment affects the lifetime of the components of the milking robot in a way that has no counterpart in the aircraft instrument field.

Moreover, the location of the milking robot gives rise to problems peculiar to the operation of milking robots in that environment. Thus, the environment of the milking robot differs radically, depending on where in the world the robot is located. Thus, milking parlors or stalls in, say, Arabia, are entirely different as to such problems from those in, say, Sweden or in humid tropical countries.

To be properly combinable, there must be some teaching or suggestion of the desirability of such combination, in one or the other of the combined references. Such teaching is completely lacking both in JAKOBSON et al., and in FINGER.

The Board of Patent Appeals and Interferences of the United States Patent and Trademark Office, as well as the United States courts, have repeatedly pointed out that the prior art references must either expressly or impliedly suggest the claimed invention, or the Official Action must convincingly reason why one skilled in the art would have found the claimed invention obvious, in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 973 (Board of Patent Appeals and Interferences, 1985). In the present situation, there is simply no teaching or suggestion available in either of the combined references, to provide the requisite motivation to combine them.

The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the Examiner. *In re Piasecki and Meyers*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir.

1984). In establishing a *prima facie* case of obviousness under 35 USC 103, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. *Ex parte Clapp*. To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from applicant's disclosure. See, for example, *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Furthermore, as stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983),

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Thus, the combination of JAKOBSON et al. and FINGER, used against the claims of the present application, is made only by impermissible hindsight, using the applicant's own teaching as a template or blueprint for the combination of references, taking from the references selectively that material which is to be combined, without regard for the clear mandate of the Board and the courts that this is not to be done.

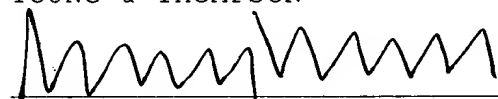
In view of the foregoing, therefore, it is believed that this application is in condition for allowance, and reconsideration and allowance are respectfully requested.

The undersigned has been expressly authorized to conduct an interview in the present application. On the one hand, we do not wish to waste the Examiner's time and the applicant's money with an unnecessary interview if, as we believe, the above places the application in condition for allowance. On the other hand, the applicant is most anxious that this application not be placed under "final" rejection, without an interview first being held. Therefore, if for any reason the Examiner cannot now allow the application, she is respectfully requested to call the undersigned to arrange such an interview.

Respectfully submitted,

YOUNG & THOMPSON

By



Robert J. Patch  
Attorney for Applicant  
Registration No. 17,355  
745 South 23rd Street  
Arlington, VA 22202  
Telephone: 521-2297

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